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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/006,693
Filing Date: December 10, 2001
Appellant(s): SESEK ET AL.

MAILED
MAY 22 2007
GROUP 3600

Hewlett-Packard Development Company, L.P.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/25/2006 appealing from the Office
action mailed 1/13/2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent No. (5,923,834)	Thieret et al.
EP No. (0 822 524 A2)	Paton
US Patent No. (5,305,199)	LoBiondo et al.
US Pub. No. (US 2003/0071726 A1)	Hopper et al.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 62-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 62 and 79 recite access to "usage information indicative of usage of an expendable which is used over a period of time" and comparing the "usage information with the usage profile data". However, the specification and original claims appear only to describe access to usage rate information and comparison of the usage rate information with the usage profile data [indicative of expected usage rate]. The recitation of accessing and comparing usage information, as opposed to usage rate information, does not appear to be described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62, 66-71, 79-82, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thieret (5,923,834) in view of Paton.

Thieret shows a controller configured to access usage rate profile data, comprising stored wear rate data or use rate of a consumable items; to monitor a parameter of the system indicating component wear or consumption of consumable items (e.g., col. 9, lines 50-55; col. 11, lines 17-23); and to generate an alert. Thieret does not explicitly show comparing the parameter with the usage rate data and generating the alarm when parameter deviates from the rate profile data. Paton shows comparing the parameter with the rate profile data, and generating an alert when the parameter deviates from the rate profile data. It would have been obvious to one of ordinary skill in the art to modify the method of Thieret by performing the steps of Paton in order to provide a warning when maintenance may have to be performed sooner than expected.

As to claims 66 and 82, Thieret in view of Paton show usage wear comprising wear of a consumable part.

As to claim 67, Thieret in view of Paton show all elements except that the controller is configured to identify the type of imaging occurring and to adjust the

indication of wear responsive to the identification. ***The Examiner takes official Notice that it is notoriously old and well known in the art*** for a controller to be configured to identify the type of imaging occurring and to adjust the indication of wear responsive to the identification. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Thieret by configuring the controller to identify the type of imaging occurring and to adjust the indication of wear responsive to the identification in order to better deal with different types of imaging situations.

As to claims 68, Thieret in view of Paton show usage profile information derived from prior consumption of the consumable.

As to claims 69, 70, 77, 78, 84 and 85, Thieret in view of Paton show all elements of the invention except disabling the system and means for doing so. Thieret in view of Paton does however, show determining that there is a hardware failure within the system (e.g., pg. 4, lines 3-12 of Paton). ***The examiner takes official notice that it is notoriously old and well known in the art to disable a malfunctioning system (and to provide a means for doing so)***. It would have been obvious to one of ordinary skill in the art to further modify the method of Thieret by disabling a malfunctioning system in order to prevent further damage.

As to claim 71, it is noted that Thieret in view of Paton shows auto-reordering.

Claims 62-65, 68 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over LoBiondo et al (5,305,199) in view of Paton (EP 0822524).

LoBiondo shows a controller configured to access usage rate profile data, comprising use rate of a consumable items; to monitor a parameter of the system

indicating or consumption of consumable items; and to generate an alert. LoBiondo does not explicitly show comparing the parameter with the usage rate data and generating the alarm when parameter deviates from the rate profile data. Paton shows comparing the parameter with the rate profile data, and generating an alert when the parameter deviates from the rate profile data. It would have been obvious to one of ordinary skill in the art to modify the method of LoBiondo by performing the steps of Paton in order to provide a warning when additional consumables may be required sooner than expected.

As to claims 63 and 64, LoBiondo in view of Paton shows monitoring media usage comprising paper usage (see e.g., Fig. 3 of LoBiondo).

As to claim 65, LoBiondo in view of Paton shows monitoring a plurality of consumables (paper and toner).

As to claims 68, LoBiondo in view of Paton show usage profile information derived from prior consumption of the consumable.

As to claim 72, LoBiondo in view of Paton show all elements except that the controller accesses a budget plan, determines the cost of the consumption and generates an alert when the cost is over budget. ***The examiner takes official notice that it is notoriously old and well known in the art for a controller to access a budget plan, determines the cost of the consumption and generates an alert when the cost is over budget.*** It would have been obvious to one of ordinary skill in the art to further modify the apparatus of LoBiondo by having controller access a budget plan, determine

the cost of the consumption and generate an alert when the cost is over budget in order to avoid excess costs.

Claims 73, 75, 76, 83, 86, 87, 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thieret in view of Paton as applied to claims 62 and 79 above, and further in view of Hopper et al (2003/0071726).

Thieret in view of Paton show all elements of the claims except adjusting usage data to show an increased or decreased usage in response to detection of a particular type of imaging. Hopper shows this element. It would have obvious to one of ordinary skill in the art to modify the apparatus and method of Thieret by doing so in order to more accurately reflect resource expenditure.

Allowable Subject Matter

Claim 74 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed 9/25/2006, the appellants argues:

A) Claims 62-88 comply with the written description requirement (see Brief, page 3-Argument A).

In response to A) Examiner respectfully disagree. As stated in the office action dated 1/13/2006 Claims 62-88 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 62 and 79 recite access to "usage information indicative of usage of an expendable which is used over a period of time" and comparing the "usage information with the usage profile data". However, the specification and original claims appear only to describe access to usage rate information and comparison of the usage rate information with the usage profile data [indicative of expected usage rate]. The recitation of accessing and comparing usage information, as opposed to usage rate information, does not appear to be described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

B) There is insufficient motivation to combine the teachings of Paton with the teachings of Thieret and the 103 rejections of claims 62, 67-71, 73, and 75-88 is improper for at least this reason (**see Brief, page 7-Argument B**).

In response to B) Examiner respectfully disagrees. Regarding Appellant's argument believed to be directed toward nonanalogous subject matter, the examiner notes that it would have been reasonable to look to Paton since both references are concerned with the same subject matter – monitoring of expendable items of a system.

Furthermore, although our predecessor court was the first to articulate the motivation suggestion-teaching test, a related test---the "analogous art" test---has long

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been part of the primary Graham analysis, articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on the reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. "[I]t is necessary to consider 'the reality of the circumstances,'---in other words, common sense---in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor".

Also in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have had sufficient motivation to combine the individual [elements] forming the claimed [invention]." See In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Regarding Appellant's argument there is insufficient motivation to combine references, the test for combining references is what the references, as a whole would have suggested to one of ordinary skill in the art. See e.g., In re Sheckler, 168 USPQ 716 CCPA 1971); In re McLaughlin, 170 USPQ 209 (CCPA 1971).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case it would be extremely advantageous to incorporate the teachings of Paton into the disclosure of Thieret, for the purpose stated in the previous final action dated 01/13/2006 which is to provide a warning when maintenance may have to be performed sooner than expected. Therefore, in view of the above evidence, Thieret and Paton, still meets the scope of the limitations as currently claimed.

Regarding applicant's argument that the teachings of Paton are redundant, the examiner notes that it is possible to use the data as taught by Thieret and to modify the system to use it as taught by Paton as well.

C) There is insufficient motivation to combine the teachings of Paton with the teachings of LoBiondo and the 103 rejections of claims 62-65, 68 and 72 is improper for at least this reason (see Brief, page 10-Argument B).

87.
5/17/07.
In response to ^C B), the examiner respectfully disagrees. Regarding Appellant's argument there is insufficient motivation to combine references, the test for combining references is what the references, as a whole would have suggested to one of ordinary skill in the art. See e.g., *In re Sheckler*, 168 USPQ 716 CCPA 1971); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case it would be extremely advantageous to incorporate the teachings of Paton into the disclosure of LoBiondo, for the purpose stated in the previous final action dated 01/13/2006 which is to provide a warning when additional consumables may be required sooner than expected. Therefore, in view of the above evidence, Paton and LoBiondo, still meets the scope of the limitations as currently claimed.

Regarding applicant's argument that the teachings of Paton are redundant, the examiner notes that it is possible to use the data as taught by LoBiondo and to modify the system to use it as taught by Paton as well.

D), E), F) and I) Appellant is arguing that official notice traversal is adequate, (see Brief pages 13, 17, 18 and 21-Arguments D, E and I).

In response to D), E), F) and I), the examiner respectfully disagrees. The examiner notes that Applicant's traversal is inadequate. MPEP 2144.03(c) requires that the Applicant the subsequent action adequately traverse the statement that certain subject matter is old and well known art. It further notes that an adequate traversal must state why it is believed that the subject matter is not old and well known.

MPEP 2144.03(c) states C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not

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Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

The appellant failed to specifically point out the supposed errors in the examiner's action dated 7/27/2005, and to state why the notice fact is not considered to be common knowledge or well known in the art, therefore In view of the inadequate traversal, and in light of the requirements of 2144.03(c), as stated in the previous action dated 1/13/2006, the examiner notes that the well known in the art statements of the previous Office Action are considered to be admitted prior art.

G) There is insufficient motivation to combine the teachings of Hopper with the teachings of Thieret and Paton and the 103 rejections of claims 73, 75, 76, 83, and 86-88 is improper for at least this reason (**see Brief, page 19-Argument G**).

In response to G), the examiner respectfully disagrees. Regarding Appellant's argument there is insufficient motivation to combine references, the test for combining references is what the references, as a whole would have suggested to one of ordinary skill in the art. See e.g., *In re Sheckler*, 168 USPQ 716 CCPA 1971); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case it would be extremely advantageous to incorporate the teachings of Paton and Thieret into the disclosure of Hopper, for the purpose stated in the previous final action dated 01/13/2006 which is to more accurately reflect resource expenditures. Therefore, in view of the above evidence, Hopper, in view of Paton and Thieret, still meets the scope of the limitations as currently claimed.

H) Positively recited limitations of claims 73, 75, 76, 83 and 86-88 are not disclosed by the prior art references Thieret, Paton, and Hopper and the 103 rejection is improper for at least this reason, (see **Brief, page 20-Argument H**).

In response to H), The Examiner respectfully disagrees and would like to direct the Board of Appeals and appellant's attention to the fact that Thieret and Paton were not relied upon to teach the claimed limitation adjusting usage data to show an

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increased or decreased usage in response to detection of a particular type of imaging. Examiner relies on Hopper as a third reference that was utilized to teach the deficiencies of primary reference Thieret, and the secondary reference Paton, as stated in the final office action dated 01/13/2006. Hopper discloses a computer which includes a printer monitoring program that generates information through a graphical user interface (see at least fig. 2) on the amount remaining for resources in the printer, the usage data is adjusted according to the usage depletion of the resources in the printer.

See at least Paragraph [0021], which states the following:

"[0021] The computer 2 includes a printer monitor program 30 that generates information through a graphical user interface (GUI) on the amount remaining for resources 10a, 10b, 12a, 12b, 14a, 14b in the printers 4a, 4b. FIG. 2 illustrates a printer status window 32 displayed within a monitor 34 (FIGS. 1 and 2) attached to the computer 2 that is generated by the printer monitor program 30. In the printer status window 32, the printer monitor 30 displays a toner status gauge 36a and 36b for each printer 4a and 4b, respectively, that the printer monitor 30 monitors over the network 6. In FIG. 2, the printer's 4a and 4b are shown as named "First Floor Printer" and "Marketing Printer", which describes where in the facility the printers 4a and 4b are located. The toner status gauges 36a and 36b are displayed with a needle 38a and 38b that can extend from 0 grams to the capacity of the toner cartridge, which in the case of the toner cartridge in printer 4a is 300 grams and for printer 4b is 400 g. While the printer's 4a and 4b are operating, the gauges 36a and 36b display an estimate of the amount of toner, or other monitored resource, remaining."

Therefore in view of the above evidence, Thieret, in view of Paton in further view of Hopper, still meets the scope of the limitations as currently claimed.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mussa Shaawat



Conferees:

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Ryan Zeender
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AU 3627

